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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,453	03/28/2001	Michael J. Borg	10006797-1	6680

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Intellectual Property Administration  
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EXAMINER

GRAYSAY, TAMARA L

ART UNIT	PAPER NUMBER
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3636

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/820,453

Applicant(s)

BORG ET AL.

Examiner

Tamara L. Graysay

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-5, 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMahon (US-5789732) in view of Bullock (US-5835817).

Claims 1, 2, 4, 5, 7-11 and 26: McMahon discloses a method for retrieving data from the memory on a replaceable component (the consumer card 10 contains a memory of data related to consumer purchases); storing the data in a marketing database (the coupon generating system is a marketing database, col.4:10-42); associating the data with products (the purchasing history of the consumer associates the consumer with product purchase data and potential marketing solutions, such as coupons); searching the database for products (the search is performed regarding coupon and promotional discount opportunities for various products previously purchased that can be used in the current visit, col.4:19-22); and applying a predetermined marketing solution (the marketing solutions are download coupon and promotional discount opportunities that are redeemed at the point of sale, col.4:22-35). In general terms, McMahon discloses applying a predetermined marketing solution or scheme after retrieving from a memory card information about a user's purchase history in order to market previously consumed goods or other goods associated with the previously consumed goods.

On one hand McMahon is a memory on a replaceable component used for products in general (the card that holds the memory is a replaceable consumer product), the memory is not specific to data associated with a component used in a first printing device.

On the other hand Bullock teaches a memory on a replaceable component used in a first printing device (cartridge stores data on its memory chip, 7:55-60). This teaching is indicative of the printing art and the benefits of retrieving or retaining printing device data on a component memory. Such benefits include avoiding the use non-compatible or counterfeit components in a printing device.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify McMahon to include information about print cartridge usage, such as suggested by the Bullock method, in order to ensure that a consumer receives an appropriate or predetermined marketing solution, i.e., appropriate coupon and promotional discounts based on the customer's use of a replaceable component. Applicant's method includes applying a marketing solution for a "second" printing device that meets certain criteria based on printing device data about a "first" printing device, i.e., a marketing strategy based on data about previously consumed products. The use of the descriptor first and second are not of particular importance insofar as the claim has not distinguished them from each other and the first and second printing device can be the same type of printing device. Alternatively, if the first and second printing devices are different, such a strategy is well known in the marketing field (at page 2 under MARKETING, the Magnet article, Who's winning the information revolution, describes an example of the marketing solution of using one product to recommend or entice a

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consumer to buy a different / compatible / substitute product based on prior consumption patterns).

Claim 3: The data stored about the printing device in the McMahon and Bullock combination is an “environment” insofar as the information is about the use of the printing device and its component. The “environment,” as broadly recited, is printing.

Claim 26: The limitation “the replaceable component used *during by printing* by the first printing device” does not define over the McMahon and Bullock combination, insofar as the claim limitation has been interpreted to mean that the first printing device uses the replaceable component during printing. The claim does not require a step of printing, does not positively recite the first printing device or the replaceable component. The claim begins with the step of retrieving memory from a component memory. The use of the replaceable component is not part of a positive step or activity, such as printing, or using or operating (as mentioned in the specification at page 10).

2. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over McMahon (US-5789732) and Bullock (US-5835817), as applied to claim 1 above, and further in view of Burdick (US-5625816).

Claim 6: Burdick teaches a quality control data that permits users to improve quality based on the data about a particular device, element of a device, or production line.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the McMahon and Bullock combination to include a quality control data field, such as taught by Burdick, in order to improve the quality of the printer cartridge based on the data that is retrieved from the memory chip on the printer cartridge.

***Response to Arguments***

3. Applicant's arguments filed 04 January 2006 have been fully considered but they are not persuasive.

a. Page 7: Applicant argues that the consumer data device is a standalone device that is not a replaceable component of any device. In response, the consumer data device is replaceable. In the combination, the use of the consumer data device in the printing device field would have been obvious as noted above. The purchase of a first printing device is associated with the consumer data device of McMahon as modified by Bullock and thus, includes printing device data as broadly recited. In fact, the purchase of printing products is printing data as broadly recited.

b. Page 8: Applicant argues that motivation is required to use the replaceable component of Bullock in place of the consumer data device of McMahon. In response, the claim is a process claim, not an apparatus claim. The replaceable component is not being replaced but rather the use of the consumer data device in the field of printing is what is being modified. The consumer data device is known, as evidenced by McMahon. However, McMahon lacks the particular data that is retrieved, or in other words, the use of the device in any particular spending area. The teachings in Bullock are directed to marketing in the printing field and the application of printing data in the selection of marketing solution. The claim includes nothing unexpected in marketing or data retrieval or marketing. The data is retrieved from a memory (not a new concept or unexpected result) and the marketing solution is selected from a marketing database (storage of data and searching stored data are not new or cause any unexpected result).

c. Page 8 to 9: Applicant argues that the printing device data derived from the first printing device used in applying a pre-determined marketing solution for the second printing device is important because marketing solutions for a second printing device can be created based on printing device data derived from a known printing device. In response, the claim does not require a step of creating a marketing solution. The marketing solution is pre-determined, according to the claim language. Moreover, the claim language does not require any information about the first printing device during the last two steps. The activities related to the searching and applying steps do not manipulate the retrieved printing data and the retrieved printing data is not associated with data about the first printing device.

d. Page 9: Applicant argues there is no motivation to combine coupons issued and used in a store as taught in Magnet, with the McMahon and Bullock combination. In response, the modification is not to use coupons. Magnet describes a well known cross marketing solution strategy associated with a second product based on purchase or information related to a first product. Thus, the teaching is that in the combination, it would have been obvious to one of ordinary skill in the art to cross market printing devices if, as a practical matter, a performer of the process were to give weight to the type of product (a first printing device and a second printing device) in the method claim.

e. Page 10: Applicant argues that “environment” is directed to computing environments such as distributed computing environments. In response, applicant has not mentioned any particular portion of the specification that is relied upon for this argument. Further, if the argument is grounded in the specification, limitations from the specification cannot be read into the claims.

f. Page 11: Applicant argues that there is no teaching as to how the Burdick product performs in a device such as a printer. In response, the claims are directed to a process, not an apparatus. The teachings in Burdick are that quality control data are collected and used to improve products. This quality control process is well known and as such, applying the process to the McMahon and Bullock combination would have been obvious in order to, as mentioned in Burdick, improve products.

***Conclusion***


4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamara L. Graysay whose telephone number is 571-272-6728. The examiner can normally be reached on Mon - Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Cuomo, can be reached on 571-272-6856. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 3/20/06  
Tamara L. Graysay  
Examiner  
Art Unit 3636